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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/509,775 03/31/00 FUJITA

J 053466/0277

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HM12/0531

EXAMINER
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WELLS, M	
ART UNIT	PAPER NUMBER

1642  
DATE MAILED:

7  
05/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/509,775

Applicant(s)

FUJITA, JUN

Examiner

Matthew O. Wells

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-34 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-5 and 16-17, drawn to a polypeptide comprising an amino acid sequence of SEQ ID NO: 2.

Group II, claims 6-9, drawn to a polypeptide comprising the amino acid sequence of SEQ ID NO: 4.

Group III claim(s) 10, drawn to a polypeptide encoded nucleotide sequence as set forth in SEQ ID NO: 3.

Group IV, claim(s) 11-14, drawn to a polypeptide comprising an amino acid sequence of SEQ ID NO: 6.

Group V, claim(s) 15, drawn to a polypeptide that is encoded by a DNA capable of hybridizing to a DNA having the nucleotide sequence as set forth in SEQ ID NO: 5.

Group VI, claims 18-21, drawn to a DNA encoding a polypeptide according to claim 1.

Group VII, claim(s) 22-24, drawn to an antibody recognizing the polypeptide of claim 1, and a method of use for the antibody.

Group VIII, claim 25, drawn to the method of detecting a gankyrin polypeptide.

Group IX, claim(s) 26-28, drawn to an antisense oligonucleotide that hybridizes to any of the sites of the nucleotide sequence, as set forth in SEQ ID NO: 1.

Group X, claim(s) 29-30, drawn to the method of screening for an agonist or an antagonist of the binding of the gankyrin polypeptide and Rb.

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Group XI, claims 31-32, drawn to the method of screening for an agonist or an antagonist of the binding of the gankyrin polypeptide and NF $\kappa$ B.

Group XII, claim 33, drawn to an agonist of the gankyrin polypeptide.

Group XIII, claim(s) 34, drawn to an antagonist of the gankyrin polypeptide.

The inventions listed as Groups I-XIII do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking groups I-XIII appears to be that they all have the biological activity of gankyrin.

However, in view of JP, 9-75085, A (Sagami Chemical Research Center), 25 March, 1997 (25.03.97) (Family: none), as set forth in the PCT Search, the special technical feature is lacking.

Therefore, the technical feature linking the inventions of groups I-XIII does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

The special technical feature of Group I is considered to be a polypeptide comprising an amino acid sequence of SEQ ID NO: 2.

The special technical feature of Group II is considered to be a polypeptide comprising an amino acid sequence of SEQ ID NO: 4.

The special technical feature of Group III is considered to be a polypeptide encoded by a nucleotide sequences as set forth in SEQ ID NO: 3.

The special technical feature of Group IV is considered to be a polypeptide comprising an amino acid sequence of SEQ ID NO: 6.

The special technical feature of Group V is considered to be a polypeptide encoded by a DNA capable of hybridizing to a DNA having the nucleotide sequence as set forth in SEQ ID NO: 5.

The special technical feature of Group VI is considered to be a DNA encoding a polypeptide according to claim 1.

The special technical feature of Group VII is considered to be an antibody recognizing the polypeptide of claim 1.

The special technical feature of Group VIII is considered to be a method of detecting a gankyrin polypeptide.

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The special technical feature of Group IX is considered to be an antisense oligonucleotide that hybridizes to any of the sites of the nucleotide sequence, as set forth in SEQ ID NO: 1.

The special technical feature of Group X is considered to be a method of screening for an agonist or an antagonist of the binding of the gankyrin polypeptide and Rb.

The special technical feature of Group XI is considered to be a method of screening for an agonist or an antagonist of the binding of gankyrin polypeptide and NFκB.

The special technical feature of Group XII is considered to be an agonist of the gankyrin polypeptide.

The special technical feature of Group XIII is considered to be an antagonist of the gankyrin polypeptide.

Accordingly, Groups I-XIII are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

2 Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O. Wells whose telephone number is 703-308-4521.

The examiner can normally be reached on M-F (7:00-4:30), every other Monday off.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Matthew Wells  
May 21, 2001



MARK NAVARRO  
PRIMARY EXAMINER